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AF/3761

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AR&E Docket No. 28951/3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	:	Bernard Daskal
Serial No.	:	09/489,655
Filed	:	January 24, 2000
For	:	COLORED PANTY LINERS
Examiner	:	Catharine L. Anderson
Group Art Unit	:	3761

"Express Mail" mailing label No. EV 335774874 US
Date of Deposit: November 26, 2003
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Name: Brian Comask
Signature:

REPLY BRIEF

MAIL STOP - APPEAL BRIEF - PATENTS
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

The following Reply Brief is submitted in response to the Examiner's Answer filed on October 3, 2003.

(1) REAL PARTY IN INTEREST

The party named in the caption of this Appeal Brief, Mr. Bernard Daskal, of 333 Longacre Avenue, Woodmere, 11598 is the real party in interest.

(2) RELATED APPEALS AND INTERFERENCES

None.

(3) STATUS OF CLAIMS

Claims 1 and 5-7, the only claims pending in this Application, stand under final rejection, from which this Appeal is taken. Claims 2-4 have been cancelled and are not on Appeal.

(4) STATUS OF AMENDMENTS

No amendment has been filed subsequent to final rejection.

(5) SUMMARY OF INVENTION

See Appeal Brief dated October 18, 2002.

(6) ISSUES

See Appeal Brief dated October 18, 2002.

(7) GROUPING OF CLAIMS

See Appeal Brief dated October 18, 2002.

(8) SUMMARY OF EXAMINER'S ANSWER

In the Examiner's Reply dated October 3, 2003, Examiner repeats her rejection of Claims 1 and 5-7 which were previously stated in the May 29, 2002 Office Action (see Examiner's Answer, par. 10, p. 2-3).

In Examiner's response to Applicants' arguments (see Examiner's Answer, par. 11, p. 4), Examiner argues that Applicants have "recognized another advantage which would flow naturally from following the suggestion of the prior art" and thus is obvious. *Citing Ex*

Parte Obiaya, 227 USPQ 58, 60 (Bd.Pat.App. & Int. 1985). In Examiner's view, even though it would not be obvious to make a darkly colored topsheet for the purposes relating to the Rabbinic decree concerning *Niddah*, it would be obvious for the purposes of masking. On this basis, Examiner concludes that the cited Van Iten and Datta references do not teach away from the claimed invention.

(9) SUMMARY OF PROCEDURAL HISTORY OF APPLICATION

Before responding substantively to the Examiner's Answer, Applicant believes a few words about the procedural history of the present application are appropriate and necessary.

Applicant filed its Appeal Brief on October 18, 2002 but did not receive an Examiner's Answer until nearly one year later, on October 3, 2003. A series of noteworthy events occurred between Applicant's filing of its Appeal Brief and the Examiner's Answer which caused this delay. Applicant respectfully believes this delay is attributable to the U.S. Patent Office, and not the Applicant. Since the prosecution file does not appear to include any record of these events, Applicant takes this opportunity to summarize such events for the record with the hope of precluding any adverse findings against Applicant in the future.

After several months elapsed since filing its Appeal Brief and having received no response from either the Examiner or the Appeal Board, Applicant's counsel called the Appeal Board to inquire as to the status of its Appeal. Counsel was advised by personnel

at the Appeal Board that it did not receive the Appeal Brief or any related information from the Examiner and suggested that a call be placed to the Examiner for further inquiry. Accordingly, Counsel called the Examiner and was advised that the Examiner did not forward the Appeal Brief to the Appeal Board because she was withdrawing her rejection and issuing a new Office Action based on newly found prior art. After this conversation, several months passed by and Applicant had not received the expected Office Action. Growing concerned, counsel placed a follow-up call to the Examiner inquiring when Applicant should expect to receive the Office Action. The Examiner advised that she would look into the matter and respond shortly.

To Applicant's surprise, the Examiner did not issue an Office Action as expected, but rather filed an Answer to the Appeal Brief on October 18, 2003. This response is long overdue, without explanation and is contrary to MPEP 1208, which states that the Examiner's answer should be filed within 2 months of receipt of Applicant's Appeal Brief.

Applicant's Appeal has now languished in the Patent Office for more than a year. Applicant respectfully requests that this Appeal be promptly carried forward, and if possible, on an expedited basis.

(10) RESPONSE TO EXAMINER'S ANSWER

It is respectfully submitted that the Examiner's belated reply is inadequate. As explained at length in Applicant's Appeal Brief, neither the cited Van Iten or Datta Patents disclose a dark colored topsheet, as previously acknowledged by the Examiner. The dark colored topsheet, such as black, brown or red topsheet of the pending claims, is not disclosed anywhere in the cited prior art. Thus, as explained in the Appeal Brief, Examiner's reliance on *Ex parte Obiaya* is entirely misplaced.

Moreover, the Examiner conclusion that "dark colors", as required by Claim 1, would also mask stains is without support. Not only does Examiner fail to cite any prior art for this position, Examiner also appears to ignore the fact (as previously submitted) that dark colors have been shown in practice to be ineffective in masking, for example, light, non-menstrual stains such as leukorrhea. (Rule 1.132 Declaration of Sherry Daskal, par. 5, attached as Exhibit 6 to Appeal Brief.) Thus, Examiner appears to have improperly based her rejection of the claims on her own perceived knowledge or on hindsight and contrary to the only evidence of record.

Furthermore, the Examiner has not responded to Applicants argument that the colors taught by the Datta and Van Iten Patents do not fall under the "Colored Surface Exception" of the practice concerning *Niddah*, and thus, the use of such colors on a

feminine hygiene pad would render Claims 1 and 5-7 inoperable for purposes of the present invention.

Additionally, the Examiner does not appear to have considered the Declaration of Rabbi Shmuel Nieman, attached as Exhibit 4 to the Appeal Brief. This declaration makes clear that the present invention provides a long-felt need to the Jewish community, a secondary consideration of nonobviousness.

CONCLUSION

For the reasons advanced above, Applicant respectfully submits that Claims 1 and 5-7 are, as a matter of law, are patentable over the Datta and Van Iten Patents. Accordingly, Applicant respectfully requests reversal of the rejections from which this Appeal was taken and allowance of Claims 1 and 5-7.

No fees or extensions of time are believed to be necessary for the filing of this Brief. However, if any additional fees are required in connection with the filing of this

Brief, including extension of time fees, please charge the Deposit Account No. 01-1785 of the undersigned attorneys. Copies of this Reply Brief in triplicate are enclosed.

Respectfully submitted,

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Dated: New York, New York
November 26, 2003

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